

Application No. 10/035,963
Amendment filed January 21, 2004
Reply to Office Action dated October 22, 2003

REMARKS

The Official Action dated October 22, 2003 has been carefully considered. Accordingly, the changes presented herewith, taken with the following remarks, are believed sufficient to place the present application in condition for allowance. Reconsideration is respectfully requested.

By the present amendment, claim 1 is amended to include limitations from claims 7 and 14, and claim 19 is amended to include limitations from claims 26 and 33. Claims 1, 15, 19 and 34 are also amended to include a limitation from the specification at page 4, line 33. Claims 8 and 27 are amended to correspond with the amendments to claims 1 and 19, respectively. Finally, claims 77-80 are added. Claims 77 and 78 contain limitations from claims 7 and 14 and claims 26 and 33, respectively. Claims 79 and 80 contain limitations from the specification, for example at page 5, lines 7-10. It is believed that these changes do not involve any introduction of new matter, whereby entry is believed to be in order and is respectfully requested.

Claims 4, 7, 14, 26, 33 and 38-75 have been cancelled from the application. Claims 1-3, 5, 6, 8-13, 15-25, 27-32, 34-37 and 76-80 are pending in the application.

In the Official Action, claims 1-37 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner asserted the claimed invention is directed to a combination of IOP reducing agents and the specification discloses examples of one beta-adrenergic agent and one prostaglandin. The Examiner asserted however that there is no evidence that there is any per se structure/function relationship between the two compounds used in the examples and all other antiglaucomic drugs that might be found using the claimed method.

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However, Applicants submit that the methods defined by pending claims 1-3, 5, 6, 8-13, 15-25, 27-32, 34-37 and 76-80 are fully described in the present specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention, as required under 35 U.S.C. §112, first paragraph. Accordingly, this rejection is traversed, and reconsideration is respectfully requested.

More particularly, according to claim 1, the invention is directed to a method of treating a patient suffering from severe glaucoma, exhibiting optical nerve head damage and visual field defects. According to claim 19, the present invention is directed to a method of treating an individual in need of a high IOP-reduction. The methods of claims 1 and 19 comprise simultaneously administering a combination of IOP reducing agents to the eye, wherein at least one IOP reducing agent comprises a prostaglandin or a prostaglandin derivative and at least one IOP reducing agent comprises a beta-adrenergic antagonist or carbonic anhydrase inhibitor.

Attention is directed to the specification, beginning at page 4, line 8 and continuing through page 5, line 12 wherein suitable combinations of IOP-reducing agents are discussed in detail. At page 4, lines 10-12, the specification discloses that a typical combination is an IOP reducing effective amount of a prostaglandin derivative together with at least one IOP reducing agent exerting its activity through receptors other than prostaglandin receptors. Specific examples of such IOP reducing agents include cholinergic agonists, beta-adrenergic antagonists, carbonic anhydrase inhibitors and beta-adrenergic agonists, as described at page 4, lines 31-34. More specific examples of these IOP reducing agents are set forth at pages 4 and 5.


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The test for compliance with the written description requirement under 35 U.S.C. §112 is the "reasonably conveys" standard, i.e., whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the claimed subject matter, *In re Kaslow*, 217 U.S.P.Q. 1089, 1096 (Fed. Cir. 1983). In view of the teachings set forth in the specification at pages 4 and 5, it is clear that the inventors had possession of the subject matter set forth in claims 1 and 19 at the time the application was filed. Accordingly, the present claims comply with the written description requirement of 35 U.S.C. §112, first paragraph, and the rejection has been overcome. Reconsideration is respectfully requested.

It is believed that the above represents a complete response to the rejection set forth in the Official Action, and places the present application in condition for allowance. Reconsideration and an early allowance are requested.

Respectfully submitted,

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